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No. 73-207

In the
Supreme Court of the United States
OCTOBER TERM. 1973

EUGENE A. WAHL and VIBRA SCREW, INC.,
Petitioners,

vs.

VIBRANETICS, INC.,
Respondent.

RESPONSE TO THE PETITION FOR A WRIT OF CERTIORARI

THOMAS F. MCWILLIAMS
53 West Jackson Boulevard
Chicago, Illinois 60604
M. BROOKS SENN
200 West Broadway
Louisville, Kentucky 40402
Attorneys for Respondent.

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In the Indiana litigation, (CA 65-C-57 U.S.D.C., SD Ind) petitioners sued Carrier Manufacturing Co., Inc. for infringement of patent No. 3,173,583. After the usual discovery proceedings the case was tried before Judge Steckler on November 6, 7, 8, 9, 10, 11, 13 and 14, 1967 to the conclusion of defendant's case. The case was then continued for approximately nine months to August 19, 1968, when plaintiffs introduced testimony purportedly for the purpose of rebutting the case made by defendant. After the filing of briefs and arguments, the trial court entered findings of fact and conclusions of law finding patent No. 3,173,583 invalid because anticipated by certain prior art structures and patents (Appendix 56a - 77a). The trial court also followed the mandate of this court

in *Graham* v. *John Deere Co.*, (381 U.S. 1), on the question of obviousness, and determined the scope and content of the prior art (Appendix 68a), the level of the ordinary skill in the art (Appendix 69a) and concluded that on the question of obviousness the differences between the subject matter sought to be patented in the Wahl patent and the prior art referred to were such that the subject matter, as a whole, would have been obvious at the time the invention was made, to a person having ordinary skill in the art (Appendix 75a).

Thereafter, an appeal was taken to the Court of Appeals for the Seventh Circuit, briefs were filed and a decision was handed down affirming the Judgment of the trial court. In that appeal, it was urged that the trial court had completely missed the technical subject matter of the patent in suit and the prior art, and the court was asked to reverse the Judgment of the trial court.

The decision of the Court of Appeals for the Seventh Circuit appears at Appendix 20a - 55a. Relative to the argument that the trial court completely missed the technical subject matter and that the trial court did not understand the concept of the claimed invention of the patent in suit, the court stated:

> "The record refutes the suggestion that Judge Steckler was led astray. It reveals that he was keenly aware of the issues for decision and the contentions of the respective parties, and actively participated in the examination of the expert witnesses." (Appendix 29a).

In the decision of the Court of Appeals reference is made to the *Graham* v. *Deere* decision of this court (Appendix 42a).

Up to this point in the Indiana litigation, plaintiffs were represented principally by a New York patent law

firm, Pennie, Edmonds, Morton, Taylor and Adams, with Stanton T. Lawrence, Charles E. McKenney and Charles J. Brown of that firm being in attendance at the trial.

A petition for rehearing was filed in the United States Court of Appeals which was denied. The petition for rehearing was filed by new attorneys, Edward A. Haight and Haight, Hofeldt and Davis of Chicago. The thrust of this petition for rehearing was that the trial court and the Court of Appeals were in error with respect to the basic issues presented and that the patent should have been held valid. There is no reference in this petition for rehearing to the proposition that plaintiffs were denied a fair trial or that plaintiffs were precluded from introducing at the trial court level any evidence which was available to plaintiffs.

Similarly, before the trial court in the Indiana litigation, there was no petition for rehearing, nor was their any suggestion that the plaintiffs were precluded from introducing any available evidence, nor was there any motion for a new trial for the purpose of supplementing the record with any new evidence. Indeed, it would be most difficult for plaintiffs to make such an assertion because plaintiffs had a period of approximately nine months from the close of defendant's case before it introduced rebuttal testimony.

Thereafter, a petition for a writ of certiorari in the Indiana litigation was presented to this court and denied. This petition was filed on behalf of the patent owners by Edward A. Haight and John W. Hofeldt patent lawyers of Chicago. There was no suggestion in the petition for a writ of certiorari that the patent owners were denied an opportunity to present all available evidence, the main thrust of the petition being that the trial court

and Court of Appeals for the Seventh Circuit were error with respect to the issue of validity and in holdi the patent in suit to be invalid because anticipated a invalid because the subject matter thereof was obvious the time the invention was made.

In the Kentucky litigation from which this petiti emanates the complaint for infringement of patent N 3,173,583 was filed on January 9, 1971 after the decisi of the District Court in the Indiana litigation, but pri to the decision of the Court of Appeals for the Seven Circuit. Plaintiffs in the Kentucky litigation were pri cipally represented by the New York patent law firm Pennie, Edmonds, Morton, Taylor and Adams wi Stanton T. Lawrence and Charles E. McKenney bei principal counsel. Shortly prior to the decision of t Court of Appeals for the Seventh Circuit in the Kentuc litigation, Percy Foreman of Houston, Texas entered a appearance on behalf of plaintiffs. After the decision the Court of Appeals for the Seventh Circuit, the th local counsel for plaintiffs as well as the New Yo lawyers were replaced. Dugald S. McDougall, a pate lawyer from Chicago then appeared as counsel for plai tiffs together with Percy Foreman and a new local couns from Louisville, J. Leonard Walker.

Defendant's answer was amended to include appropria allegations pleading estoppel under the decision of th court in *Blonder-Tongue* (402 U.S. 313) and a motio for Summary Judgment was presented on behalf of d fendant. This motion was submitted to the trial court o briefs and the trial court applied the *Blonder-Tongu* estoppel mandated by the decision of this court an dismissed the Complaint with an opinion (Appendix 14a 19a).

The District Court in the Kentucky litigation found that there was no valid reason for not applying the *Blonder-Tongue* mandate of this court and found that the trial court in the Indiana litigation properly applied the *Graham* v. *Deere* standards, that in the Indiana litigation the trial court made the findings of fact and conclusions of law in an intelligent understanding of the technical issues involved, and that plaintiffs had been given an ample opportunity to present all evidence available to it. (Appendix 16a - 17a). The District Court in the Kentucky litigation stated:

> "The Supreme Court requires that cases of this type ultimately be decided by the trial court's sense of justice and equity. The facts reveal that plaintiff has been given a full and fair opportunity to litigate and prove the validity of his patent. As already noted, the previous trial lasted eight days and, at the conclusion of proof, patentee was given an additional nine months to offer additional rebuttal evidence. Upon losing at the trial level, plaintiff appealed; he then had ample opportunity to present to the Seventh Circuit his arguments challenging the adverse decision rendered by the District Court. Plaintiff was unsuccessful and took his case to the Supreme Court where his writ was denied. It is obvious that to allow plaintiff to relitigate here, the same issues previously decided, would not serve justice and equity but would in fact have the contrary result." (Appendix 17a)

An appeal was taken to the United States Court of Appeals for the Sixth Circuit from the order dismissing the Complaint, briefs were filed and argument had, and the Court of Appeals entered its decision affirming the Judgment of the District Court (Appendix 1a - 13a). Argument was presented both orally and by briefs to the Court of Appeals for the Sixth Circuit that the District Court improperly applied the *Blonder-Tongue* mandate of

this court. In the decision of the Court of Appeals
the Sixth Circuit the *Blonder-Tongue* decision
thoroughly analyzed and it was pointed out that
District Judge below examined all of the material av
able including the full transcript of the hearing in
Indiana litigation, and that plaintiffs had a full and
chance to litigate the validity of their patent. The Co
of Appeals pointed out that in the Indiana litigat
plaintiffs made the choice of forum and had every
portunity to litigate to the finish. Before the Court
Appeals for the Sixth Circuit, plaintiffs were represen
by J. Leonard Walker of Louisville, Kentucky, Dugald
McDougall of Chicago, Illinois and Percy Foreman
Houston, Texas.

It is interesting to note that the petition for a w
of certiorari in this case presents for the first time lawy
not heretofore heard from in this litigation, namely, T
ford Taylor and David W. Conrad. It appears that the
lawyers have been called upon to pick whatever remaini
flesh there may be from an otherwise dead carcass.

This petition for a writ of certiorari should be deni
because there is not even any assertion in the petition
any of the reasons for granting a writ as set forth
Rule 19 of this court. There is not even asserted th
there is a conflict in the decision below with any decisi
of another court of appeals in the same matter. The i
portant question of Federal Law is whether or not
patent owner is entitled to another trial concerning t
validity of his patent after it has been once held invali
This has already been settled by this court in the *Blonde*
Tongue case. There is therefore no new important Feder
question of patent law presented in the petition.

It is suggested in the petition that in the Kentucky litigation the courts disregarded the limitations set forth by this court in the *Blonder-Tongue* case. On the contrary, a reading of the decision of the Sixth Circuit Court of Appeals (Appendix 1a) and the decision of the Kentucky trial court indicates that very serious consideration was given to the *Blonder-Tongue* decision and scrupulously, the courts applied the mandate of that decision.

The petition suggests that a reason for the granting of the petition is that there has been unanimity of the trial courts and Courts of Appeal in applying the *Blonder-Tongue* decision. Since the courts have been unanimous in their interpretation of the decision of this court in the *Blonder-Tongue* case, there is certainly no reason why this court should again give that subject matter further consideration.

Petitioners also suggest that the District Court was in error in postponing the answers to the interrogatories submitted by defendant until it decided the motion for summary judgment. With a motion for summary judgment pending, it is reasonable to have the court postpone answers to interrogatories. Further, it is suggested that the answers to the interrogatories would indicate that the decision of the trial court in the Indiana litigation would be shown to be erroneous. This is a most unusual assertion because it is based upon interrogatories to which no answers were filed. It is completely speculative for petitioners to assert that these answers would in some way be helpful to petitioners' cause.

In the Indiana litigation, plaintiffs had a full and fair opportunity to litigate the patent in suit, and after a long trial the patent was held invalid. Petitioners now suggest that the Indiana trial court was in error both

with respect to its findings of fact and conclusions of law. Petitioners in effect, assert that the Seventh Circuit Court of Appeals was in error both with respect to the reliance upon the findings of fact and the conclusions of law entered by the trial court, and that the court of appeals for the Seventh Circuit was in error substantively in denying the petition for rehearing. Petitioners in effect, assert that this court was in error in denying the petition for a writ of certiorari in the Indiana litigation. Petitioners assert that the District Court in the Kentucky litigation after reviewing the transcript of the trial in the Indiana litigation was in error in not concluding that plaintiffs were deprived of a full and fair trial in the Indiana litigation and petitioners assert that the Sixth Circuit Court of Appeals, after reviewing the decision of the trial court in the Kentucky litigation was in error in affirming the District Court.

What petitioners are asserting here is that this court should disregard all of the opinions and judgments referred to above and permit plaintiffs to start all over in a new campaign of patent litigation with respect to a patent which has had the consideration of numerous courts. Under the mandate of this court in *Blonder-Tongue* this should be denied. As the court of appeals for the Sixth Circuit stated:

> "Plaintiffs' counsel suggest in their briefs that they should have been accorded a *trial* for the purpose of determining whether or not the prior trial in the District Court in Indiana, which resulted in the adjudication of invalidity, awarded to the plaintiffs a full and fair opportunity under appropriate procedure to present all evidence and witnesses in support of the patent in suit. If we were to accept this theory the whole purpose of the rule laid down by the Supreme Court in *Blonder-Tongue* would be defeated.

We, therefore, hold that such a trial is neither necessary nor advisable in a case such as this where the court in which the subsequent action is pending has available the record from the prior litigation from which it can determine whether the claim of estoppel rests upon a firm foundation based on the requirements laid down in *Blonder-Tongue.*" (Appendix 13a)

The petition for a writ of certiorari should be denied.

Respectfully submitted,

THOMAS F. MCWILLIAMS
53 W. Jackson Boulevard
Chicago, Illinois 60604
M. BROOKS SENN
200 West Broadway
Louisville, Kentucky 40402
Attorneys for Respondent.